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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,353	08/31/2001	Timothy Hla	UCT-0012-P	2675

23413 7590 06/11/2003

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EXAMINER

SCHMIDT, MARY M

ART UNIT	PAPER NUMBER
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1635

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DATE MAILED: 06/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/945,353	Applicant(s) HLA ET AL.	
	Examiner Mary M. Schmidt	Art Unit 1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

P riod for R ply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 2, and 9, drawn to methods of administration of an antagonist of EDG-1 signal transduction, further comprising an anti-angiogenic factor, classifiable in class 514, subclass 2 or 44.
 - II. Claims 1, 3, and 9, drawn to methods of administration of an antagonist of EDG-1 signal transduction, further comprising a PI-3-kinase inhibitor, classifiable in class 514, subclass 2 or 44.
 - III. Claims 1, 4, and 9, drawn to methods of administration of an antagonist of EDG-1 signal transduction, further comprising an Akt kinase inhibitor, classifiable in class 514, subclass 2 or 44.
 - IV. Claims 1, 5, and 9, drawn to methods of administration of an antagonist of EDG-1 signal transduction, further comprising wortmannin classifiable in class 514, subclass 2 or 44.
 - V. Claims 1, 6, and 9, drawn to methods of administration of an antagonist of EDG-1 signal transduction, further comprising LY294002, classifiable in class 514, subclass 2 or 44.

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VI. Claims 1, 7, 8, and 9, drawn to methods of administration of an antagonist of EDG-1 signal transduction, further comprising the DNA sequence encoding a mutated EDG-1 receptor, classifiable in class 514, subclass 2 or 44.

VII. Claims 1, 9, 10, 11 and 12, drawn to methods of administration of an antagonist of EDG-1 signal transduction, further comprising an anti-EDG-1 antibody, classifiable in class 514, subclass 2 or 44.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III, IV, V, VI and VII are unrelated from each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. Each of groups I-VII have an additional therapeutic composition to be administered such as wortmannin, LY294002, a mutated EDG-1 receptor, etc. Each of these additional therapeutic compounds renders the claimed methods distinct inventions since each method operates differently corresponding to the different therapeutic agents administered. Each of the additional compounds (anti-angiogenic factor, PI-3 kinase inhibitor, Akt inhibitor, wormannin, LY294002, mutated EDG-1 DNA and anti-EDG-1 antibody) is structurally distinct and would require each their own search and consideration on the merits. If all had to be contemplated individually with the EDG-1 for prior art and 35 U.S.C. 112, purposes, there would be an added search burden.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent classification and recognized divergent subject matter, and the search required for each of Group I, II, III, IV, V, VI or VII is not required for the other Groups, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

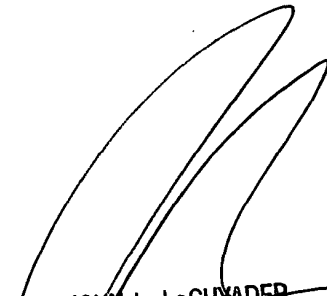
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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Mary M. Schmidt*, whose telephone number is (703) 308-4471.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *John LeGuyader*, may be reached at (703) 308-0447.

Any inquiry of a general nature or relating to the status of this application should be directed to *Katrina Turner* whose telephone number is (703) 305-3413.

M. M. Schmidt
June 9, 2003



JOHN L. LeGUYADER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600